Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte GUIDO SCHMITZ

_____

Appeal No. 2004-0315
Application No. 09/865,687

_____

ON BRIEF

_____

Before GARRIS, OWENS, and TIMM, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-20 which are all of the claims in the application.

The subject matter on appeal relates to a connector and to a reinforced molding comprising a wall which defines a cavity and which has an outer surface and an inner surface facing the cavity. The wall comprises a skin layer on the inner and outer

surfaces comprising an electrically conductive molding composition A comprising a first base polymer and an electrically conductive additive, and a core layer disposed between the skin layer on the inner surface and the skin layer on the outer surface comprising a plastic molding composition B (which differs from molding composition A), wherein the skin layer on the inner and outer surface provides a continuously conductive path from the inner surface to the outer surface. This appealed subject matter is adequately illustrated by independent claim 20 which reads as follows:

20. A reinforced molding, comprising a wall which defines a cavity, said wall having an outer surface and an inner surface facing the cavity, wherein the wall comprises:

A) a skin layer on the inner and outer surface of said reinforced molding, comprising an electrically conductive plastic molding composition A comprising a first base polymer and an electrically conductive additive; and

B) a core layer disposed between the skin layer on the inner surface of the wall and the skin layer on the outer surface of the wall comprising plastic molding composition B which differs from molding composition A, and which comprises a second base polymer and at least one reinforcing material, wherein the skin layer on the inner and outer surface provide a continuously conductive path from the inner surface to the outer surface of the reinforced molding.

The reference set forth below is relied upon by the examiner in the section 102 rejection before us:

Baumann et al. (Baumann) 6,316,537 Nov. 13, 2001
(filed Nov. 17, 1999)

All of the appealed claims on appeal stand rejected under 35 U.S.C. § 102(e) as being anticipated by Baumann.

This rejection cannot be sustained.

Each of the independent claims on appeal expressly requires that a skin layer be on the inner and outer surface and comprise an electrically conductive plastic molding composition which comprises a first base polymer and an electrically conductive additive. The examiner is correct that Baumann discloses embodiments (e.g., see lines 56-67 in column 6 and lines 1-30 in column 7) which include an antistatic inner layer that reads on the here claimed skin layer on the inner surface. We agree with the appellant, however, that patentee contains no teaching of such a skin layer on the outer surface of his product embodiments in accordance with the appealed independent claims. In Baumann's embodiments, the outer surface layer is disclosed simply as being a polyamide molding composition without any indication that the composition possesses an electrically conductive characteristic or contains an electrically conductive additive.

In support of her opposing view, the examiner expresses the following position on page 3 of the answer:

> However, it is to be pointed out that the multi-layer pipes in Baumann are connectors and are composed of an antistatic inner layer and an outer layer made from a polyamide molding composition (see col. 7, lines

> 15-30) and the polyamide molding composition is conductive due to the fact that it contains a conductive additive such as conductivity black or carbon fibers, (see col. 4, lines 10-17 and col. 7, lines 30-35). Therefore, Baumann clearly teaches a connector having a conductive layer on the inner and outer surface of the connector.

The deficiency of the examiner's position is that the cited portions of Baumann's disclosure in columns 4 and 7 are not directly related by patentee's teachings to the polyamide molding composition on the outer surface of patentee's product embodiments. In fact, we find no disclosure anywhere in the Baumann patent that the outer layer of patentee's products possesses an electrically conductive characteristic or includes an electrically conductive additive.

In order for the examiner's section 102 rejection to be proper, the Baumann reference must clearly and unequivocally disclose the appellant's claimed subject matter or direct those skilled in the art to this subject matter without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the reference. See In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). While Baumann includes the disclosure of a polyamide composition containing an electrically conductive additive, patentee's teachings relate this disclosure only to the antistatic inner

layer of his product embodiments. The examiner's association of this disclosure with the polyamide composition of Baumann's outer layer simply is not anticipatorily supported by patentee's teachings.

In addition to the foregoing, the appellant also argues that Baumann contains no teaching of the independent claim feature wherein "the skin layer on the inner and outer surface provide a continuously conductive path from the inner surface to the outer surface." We agree. As discussed above, the Baumann patent contains no teaching that the outer surface layer is electrically conductive. Even if the patent were not deficient in this regard, the reference still would not anticipate the claim feature under review. This is because, as explained by the appellant in the reply brief, electrically conductive layers could be disposed respectively on inner and outer surfaces without being physically connected to each other and thereby failing to provide "a continuously conductive path from the inner surface to the outer surface" as required by the appealed independent claims.

For the above stated reasons, the examiner's anticipation finding with respect to the subject matter defined by appealed independent claims 1 and 20 is incorrect. It follows that we

cannot sustain the examiner's section 102 rejection of claims 1-20 as being anticipated by Baumann.

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris Administrative Patent Judge	)	
Terry J. Owens Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Catherine Timm Administrative Patent Judge	)	

BRG:tdl

Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314